

DOCKET NO.: 1247-0862-6E



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:

GROUP: 3727

Remy BADIN, et al.

SERIAL NO: 09/534,973

EXAMINER: CRONIN, S.

3<sup>rd</sup> RCE February 1, 2005

FILED:

FOR: HOLLOW GLASS PRODUCT WITH OFFSET COLLAR AXIS AND  
PROCESS OF MANUFACTURING THE SAME

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

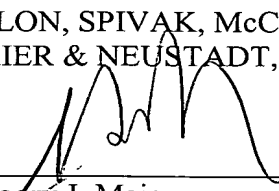
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
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Gregory J. Maier  
Registration No. 25,599

Customer Number

**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220  
(OSMMN 07/05)

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Robert T. Pous

Registration No. 29,099



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IN RE APPLICATION OF :  
REMY BADIN, ET AL. : EXAMINER: CRONIN, S.  
SERIAL NO: 09/534,973 :  
3<sup>RD</sup> RCE FILED: FEBRUARY 1, 2005 : GROUP ART UNIT: 3727  
FOR: HOLLOW GLASS PRODUCT WITH :  
OFFSET COLLAR AXIS AND PROCESS  
OF MANUFACTURING THE SAME

REMARKS ACCOMPANYING  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference in the above-referenced application be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

OBVIOUSNESS REJECTION

Applicants submit that the Final Official Action of September 9, 2005 has failed to provide a *prima facie* case of obviousness with respect to the rejection of Claims 1-5 and 16-33 under 35 U.S.C. § 103,<sup>1</sup> in view of Paley and Jennings. As outlined in detail in the Request for Reconsideration filed on October 24, 2005,<sup>2</sup> this rejection is deficient because

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<sup>1</sup> See Official Action of September 9, 2005, detailing the rejection of Claims 1-5 and 16-33 as being unpatentable under 35 U.S.C. § 103(a) over Paley (U.S. Patent No. 1,971,164) in view of Jennings (U.S. Patent No. 4,079,859).

<sup>2</sup> See the Request for Reconsideration filed on October 24, 2005, pages 2-6.

there is no motivation to modify Paley by the teaching of Jennings because Paley clearly and specifically teaches away from the proposed modification.

Applicants' Claims 1 recites, *inter alia*, a glass product comprising a collar extending beyond a cross section of a main body. Applicants' Claims 18 recites, among other features, a glass product, comprising a container body extending along an axis in an about vertical direction, a collar extending along an axis at a first angle relative to the axis of the main container body, and a secondary container body extending along an axis in a second angle relative to the axis of the collar.

The outstanding Office Action acknowledges that several features of the claimed invention are not taught or disclosed by Paley. In particular, it is acknowledged that Paley fails to disclose a collar extending beyond a cross section of the main container body. Jennings is cited as allegedly correcting the acknowledged deficiencies of Paley.

In Paley, there is no inclination of the reading tube 19 with respect to the body portion 11. "The tube 19 and neck 17 are substantially wholly within the horizontal cross-sectional circular outline of the body 11. With this construction the bottle 10 may be readily fitted into the seat or container on the centrifuging machine."<sup>3</sup> In the second embodiment disclosed by Paley, "the outer rim 25 of the neck 17a, however, is disposed wholly within the circular outline of the body, as shown in FIG. 4 of the drawing."<sup>4</sup> In fact, in the invention claimed, "said reading tube and inlet opening being wholly contained within the transverse circular outline of the body of the bottle."<sup>5</sup>

If the container of Paley were to be modified as proposed by the Office, contrary to the specific teachings of that reference, the resulting modification would either not readily fit

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<sup>3</sup> Paley, page 1, lines 93-98.

<sup>4</sup> Paley, page 2, lines 25-28.

<sup>5</sup> Paley, Claim 1.

into the seat or container on the centrifuging machine (thus, rendering the modified container unsatisfactory for its intended use) or that machine would have to be substantially modified in order to accommodate a container comprising a reading tube and an inlet or mouth extending from the cross section of the bottle 13 (thus, requiring a substantial reconstruction and redesign). Applicants respectfully submit that the record is devoid of any evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.

The Outstanding Office Action asserts that the modification to make the proposed modification of Paley with the teachings of Jennings is that both are directed to “providing a means for dispensing measured liquids.” Applicants respectfully disagree and submit that, even if assuming *in arguendo* that Jennings relates to techniques and apparatuses for measuring liquids and granular materials, Paley relates to bottles for testing butter, cheese, cream, milk, and the like substances for fat content and not for dispensing them.

In response to the arguments filed on October 24, 2005, the Advisory Action of November 10, 2005 asserted that the Request for Reconsideration previously filed had been considered but did not place the application in condition for allowance because:

The combination of the references as applied are still deemed proper for the reasons set forth in the claims. As to the specific size, shape, and glass content argued by applicant, these are considered inherent in the prior art and/or derived from a result effective variable.<sup>6</sup>

Applicants fail to see the relevance of the above-summarized reason in support of the asserted conclusion that the Request for Reconsideration did not place the application in condition for allowance. There are no reasons set forth in the claims. Furthermore, if the features are inherent in a cited reference (which standard is irrelevant to an obviousness rejection) and/or derived from a result effective variable, no evidence, let alone substantial evidence, has been provided to support such a position.

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<sup>6</sup> See Advisory Action of November 10, 2005, continuation of paragraph 11.

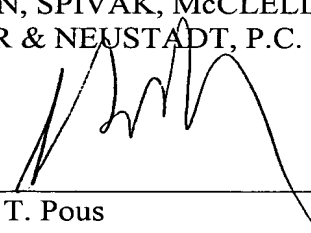
In addition, as previously explained,<sup>7</sup> the outstanding Office Action fails to explain how several of the features claimed in the dependent claims are taught or disclosed in the cited references. As a non-limiting example, the outstanding Office Action is devoid of any explanation on how or where the following features are taught or disclosed in the cited references: (1) as to Claim 24, the main and secondary container bodies, and the collar are disposed in about Y-shape; (2) as to Claim 27, the axis of the secondary container body is configured to extend at an angle of about 120° from the axis of the collar, such that the glass product has an about Y-shape; (3) as to Claims 30 and 31, the product is a blown-blown glass product or a press-blown glass product; and (4) as to Claims 31 and 32, the glass product has a single opening.

#### CONCLUSION

Based on the clear legal deficiencies in the above-noted rejections, Applicants respectfully request that prosecution be re-opened as the current grounds of rejection have not been clearly developed to such an extent that the Applicants can readily judge the Examiner's position or the advisability of preparing a traditional Appeal Brief.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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Robert T. Pous  
Attorney of Record  
Registration No. 29,099  
Mardson Q. McQuay, Ph.D.  
Registration No. 52,020

Customer Number

**22850**

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 06/04)

RTP/MQM:fm

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<sup>7</sup> See the Request for Reconsideration of October 24, 2005, page X-Y.